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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,555	01/03/2002	Norbert Huel	5/1265-1-D1	8455

28505 7590 02/12/2003

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EXAMINER

RAMSUER, ROBERT W

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-9 is/are pending in the application.

Of the above, claim(s) 1, 2, 8 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 3-7, 9 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☒ received in Application No. (Series Code/Serial Number) 09/618,170.2

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2, drawn to methods of use, variously classified.
- II. Claims 3-9, drawn to products, variously classified.

The inventions are distinct, each from the other because of the following reasons:

The above groups are identified as general areas. Accordingly, as groups they are independent of distinct as the methods of use of group I may use compounds other than those of group II, the group II compounds are capable of more than one use as note e.g. pages 41 and 42 of the instant specification and separate search considerations are involved. Also, to not restrict this application would impose a burden on its examination.

The above groups themselves are inclusive of patentably distinct subject matter. Accordingly, along with the election of one of the above groups the following action is also taken.

Claims 1 and 3 are generic to a plurality of disclosed patentably distinct species comprising for example, the method of treating plate epithelial carcinoma with (1) the compound of Example 1, (2) the compound of Example 2, (3) the compound of Example 5, etc., the compounds of (4) Example 4, (5) Example 11, (6) Example 36, etc. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

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case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Upon the election of a single disclosed species, the Examiner for examination along with the elected species will identify a generic concept inclusive of the elected species.

In response to the telephonic restriction requirement applicants' attorney Alan Stempel has elected group II and the species of Example 8 with traverse/ on August 9, 2002. The generic concept as depicted in claim 3 wherein A is optionally substituted dihalo phenyl, R1 is as is, R2 is singularly a monovalent substituent as listed, R3 is as is, R4 and R5 together denote a carbon-carbon bond, B is an optionally substituted carboxy halophenyl group, is identified for examination along with the elected embodiment. The remaining subject matter of claims 3-7 and 9 and the subject matter of claims 1, 2 and 8 stands withdrawn from further consideration under 37 CFR 1.142 (b) as constituting other patentably distinct inventions.

The withdrawn subject matter of claims 3-7 and 9 is properly restricted as said subject matter differs in structure and element from the elected subject matter so as to be patentably distinct therefrom, i.e. a reference which anticipated but the elected subject matter would not even render obvious the withdrawn subject matter and the fields of search are not co-extensive.

Accordingly, the claims are drawn to more than a single invention and restriction as has been required is proper 37 CFR 1.142(a).


Claims 3-7 and 9 are rejected under 35 USC 102(b) as being anticipated by Lennox et al (WO 99/07669, published 18 February 1999). The instantly claimed subject matter is directed to certain benzoic acid compounds and pharmaceutical composition. The reference discloses compounds (and their pharmaceutical compositions), which are anticipatory. In the reference note, e.g. compounds represented by formula (I) page 3 and pages 15-17 and compositions pages 18-19. Note particularly the specific compounds on page 13, e.g. lines 9-14 and 19-24.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Ramsuer whose telephone number is (703) 308-4534. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (703) 308-4537. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Ramsuer/LR
February 11, 2003


Robert W. Ramsuer
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